

## REMARKS

Claims 1-6, 8-14 and 16-35 are pending. Claims 1-6, 8-14 and 16-35 are rejected. The first instance of claim 30 has been previously canceled; the second instance of claim 30 is currently pending.

### Claim Rejection - 35 U.S.C. 112

The Examiner has rejected claims 20-32 and 35 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that “There is no disclosure, mention or suggestion of a user being able to set up a new parallel channel”.

It is submitted that the above feature is disclosed in the specification at least at page 8, lines 11-14 (“At step 116, the processor controls the sending of the data message by the selected delivery mechanism using the destination address determined at step 110. The data message is sent via **a new channel that runs in parallel** with the voice channel used for the telephone call” (emphasis added)).

More detail is provided at page 7, lines 7 – 15 (“When the “send to caller” option is selected at step 108, the processor 30 at step 110 automatically determines a destination address for the data message using the identifier data stored at step 102... The database associates different telephone numbers with the data delivery addresses of different persons”). The determined destination address referred to in this section is a data delivery address for communications which may use, for example, email or Bluetooth as delivery mechanisms. The Bluetooth delivery mechanism, for example, is different to the delivery mechanisms used for phone calls. Therefore when data is sent via Bluetooth, it is sent via a different channel to that used for the phone call. As the phone call and the Bluetooth communication happen simultaneously, the new channel can be referred to as a parallel channel. In view of this it is asserted that “a new channel which runs in parallel with a voice channel” is sufficiently well described in the specification.

Additionally, one skilled in the relevant art would be able to appreciate that the “processor” which “controls the sending of the data message” would be able to “set up” the channel over which the message is sent.

For at least these reasons, the specification reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, were in possession of the claimed

invention. Therefore, the Applicants respectfully request the Examiner withdraw the rejection base on 35 U.S.C. 112, first paragraph.

**Claim Rejection - 35 U.S.C. 103(a)**

The Examiner has rejected claims 1-6, 8-14, 16-19 and 33-34 as being unpatentable under 35 U.S.C. 103(a) over Lin et al. (U.S. Patent Pub. No. 2005/0096071), herein Lin, in view of Lielbriedis (U.S. Patent Pub. No. 2001/0051528), herein Lielbriedis, and in view of Paik et al. (U.S. Patent Pub. No. 2008/0153471), herein Paik. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 1-6, 8-14, 16-19 and 33-34.

These rejections are respectfully disagreed with, and are traversed below.

It is well established law that in order for an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case for obviousness. Thus, as interpreted by the Courts, the Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that in accordance with *In re Lee*, the prior art must contain a suggestion, teaching, or motivation for one of ordinary skill in the art to modify a reference or combine references; and that the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made.<sup>1</sup>

Regarding claim 1 , which recites:

“A method comprising:  
in the terminal of a first party participating in a telephone call, storing, as a consequence of the telephone call, identifier data that identifies a second party participating in the telephone call;  
using the stored identifier data to determine automatically a destination address for a data message; and  
sending, during the telephone call, a data message with the automatically determined destination address,  
wherein using the stored identifier data to determine automatically the

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<sup>1</sup> *In Re Fine*, 5 U.S.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Agmen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996); *In Re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

destination address for the data message comprises automatically interrogating a database using the stored identifier data to obtain the destination address” (emphasis added).

The Examiner observes that the combination of Lin and Lielbriedis does not “directly disclose wherein using the stored identifier to determine automatically the destination address comprises interrogating a database using the stored identifier data to obtain the destination address”.

The Examiner asserts Paik teaches:

“a caller identifier detecting unit which detects an identifier of an originating mobile terminal, a control unit which controls storage of the caller identifier information, and a call identification generation unit. The **identifier managing unit 45 manages the identifier** of the respective mobile terminal [sic] in the form of a **database** under the control of the control unit. (Para 45-47)” (emphasis added).

Assuming, arguendo, that the Examiner is correct, this discloses storing “caller identifier information”. There is no disclosure or suggestion that “caller identifier information” is analogous to a “destination address” which may be used to send “during the telephone call, a data message” as in claim 1. Rather, as disclosed in Paik, the purpose of the network-based search is to retrieve identification information **identifying the mobile station which originated a communication**. This teaches against where identifier data is used to determine a destination address for data as in claim 1.

In various embodiments of the present invention, during a telephone call either the originator or the recipient of the telephone call can send data during the telephone call. To do this an on-demand data channel is created in parallel to the one used for the telephone call. By “created in parallel” it is meant that the data channel is separate to the one used for the telephone call, but that the two channels exist simultaneously. This creation of a new data channel is achieved by automatically determining a destination address from identifier data stored as a consequence of making the phone call. This provides an advantage that the data channel need only be set up when required, thus saving resources. This feature of the creation of an on-demand parallel data channel is referred to as the “on-demand” feature.

Neither Lin, Lielbriedis nor Paik, disclose or suggest “storing, **as a consequence of the telephone call**, identifier data that identifies a second party **participating in the telephone call**” and “using the stored identifier data to determine automatically a **destination address** for a data message” by “**interrogating a database** using the stored identifier data to obtain the destination address” as in claim 1. Clearly, even if one were to combine Lin, Lielbriedis and Paik (which the Applicants do not assert there is a motivation or teaching to do), the combination of Lin, Lielbriedis and Paik, herein Lin-Lielbriedis-Paik, also would not disclose or suggest “storing, **as a consequence of the telephone call**, identifier data that identifies a second party **participating in the telephone call**” and “using the stored identifier data to determine automatically a **destination address** for a data message” by” “**interrogating a database** using the stored identifier data to obtain the destination address” as in claim 1.

Furthermore, it is unclear how one would combine Lin, Lielbriedis and Paik. Would the combination send the “SMS message” of Lielbriedis over “a voice channel during a telephone call” as in Lin while displaying “picture information, audio information, and/or character information of the caller” of Paik (see Abstract)?

Further, the three prior art documents disclose systems which perform three completely distinct functions. Assuming the functionalities of the mobile station of Lielbriedis and the first mobile station of Paik could be incorporated into the first mobile station of Lin (which the Applicants do not so assert), the resulting mobile station may be able to send data during a phone call in the same way as the mobile station of Lin, it may be able to reply to an SMS from a notification engine in the same way as the mobile station of Lielbriedis and it may be able to request the sending of identification information in the same way as the mobile station of Paik. None of the documents teach that adding on the functionality of Paik and Lielbriedis to the mobile station of Lin would be possible or desirable. As a result there would be no motivation to adapt the functionality presented in any one of the documents in the light of any of the others. If the skilled person were to combine the documents he would arrive at a device possessing three co-located functionalities. Clearly, this would still not disclose or suggest claim 1.

For at least these reasons, claim 1 is in condition for allowance. As claims 12 and 33 recite similar language to that discussed above with reference to claim 1, claim 12 is likewise in condition for allowance. As claims 2-6, 8-11, 13-14, 16-19 and 34 depend upon claims 1, 12 and 33, they are likewise in condition for allowance.

In light of the discussion above, the Applicant respectfully asserts that a prima facie case for obviousness was not presented as required by the court in *In re Lee*. As such, the Applicant respectfully requests that the Examiner reconsider and withdraw these rejections to claims 1-6, 8-14, 16-19 and 33-34.

For the foregoing reasons, the Applicant believes that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.

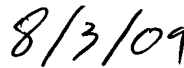
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